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Franz Bonsang

10-25-2005
Date

In the matter of the application of

Martin COUSINEAU

for: HOSE CLAMP

Owner: Martin COUSINEAU

Filed: November 20, 2003

Ser.No.: 10/716,566

Art Unit: 3679

Examiner: Aaron M. DUNWOODY

ASSISTANT COMMISSIONER FOR PATENTS

Alexandria, VA 22313-1450, U.S.A.

Sir,

This is related to, and not responsive to, the Office Action dated September 14, 2005. Accordingly, this communication is not to be construed as a response. Rather, the Applicant feels it necessary to highlight what could be perceived as irregularities in the handling of the Application by the Examiner, from the point of view of U.S. patent law and/or USPTO policy set out in the *Manual of Patent Examining Procedure*.

The Applicant notes that, in the aforementioned office action, the Examiner did not address all of the Applicant's arguments from the previous response filed on August 5, 2005 (and entered on August 31, 2005). The failure on the Examiner's

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part to address all arguments submitted appears, however, to run contrary MPEP 707.07(f) which specifically requires the Examiner to provide clear explanations of all actions taken and which recommends that the Examiner answer the substance of arguments presented. Further, the Examiner's refusal to answer all arguments and provide details of the features taught by combined references appears to be inconsistent with MPEP 706.02(j), which recommends that the Examiner should set forth the relevant teachings of the references, preferably with reference to relevant columns and page numbers. Additionally, 37 CFR 104(c)(2) requires an Examiner, when rejecting claims for want of novelty or for obviousness, to cite the best references. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Similarly, in the previous Final Office Action, the Examiner also did not address all of the Applicant's arguments submitted in the preceding response. Specifically, the Examiner did not address arguments to the effect that the Examiner had not discharged the Examiner's duty of establishing a *prima facie* case of obviousness in his first Office Action dated November 2, 2004. The requirement that the Examiner must establish a *prima facie* case of obviousness in order to sustain a rejection based on 35 U.S.C. 103 is well established in U.S. Patent law, see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, the rule that it is the burden of the Examiner to establish the *prima facie* case is also settled law, *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Furthermore, specific attempts by the Applicant to persuade the Examiner to better clarify the Examiner's position have not proven effective. For example, the Applicant notes that despite an explicit request from the Applicant in his first

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response (filed on February 2 and March 4, 2005) that the Examiner clarify the pertinence of the teachings cited thereby by providing (paragraph(s), line(s), or Figure(s)...) to precisely specify the features, or their equivalents, claimed in pending claims 16-18 & 20 (and most recently 22) in the Oetiker (US 5299344) prior art reference, the Examiner has consistently declined to provide such information. Again, this appears inconsistent with MPEP 706.02(j), MPEP 707.07(f), and, in particular, 37 CFR 1.104(c)(2). In addition, the Examiner has consistently declined to address, from the beginning of the Examination procedure, the substance of arguments relating to the requirement that the Examiner must establish the *prima facie* case of obviousness. Moreover, after mailing a Final Office Action on June 6, 2005, the Examiner refused to conduct a telephone interview with the undersigned with regard to the ongoing difficulties encountered in the prosecution and the concerns outlined above in the present communication. The Examiner simply stated that all of the Applicant's concerns should be expressed in writing in the corresponding response. The Applicant complied with the instructions of the Examiner. However, once again, the Examiner did not respond to these concerns in the following and currently pending office communication.

In light of the Examiner's ongoing refusal to provide details regarding the features of the cited prior art and to answer the substance of the Applicant's arguments, as described above, the Applicant is respectfully requesting corrective action on the part of the Examiner to ensure that prosecution of the Application may be conducted in a manner consistent with U.S. patent law and USPTO patent prosecution policy. Specifically, the Applicant requests that the pending Office Action be withdrawn and a complete office communication, addressing all of the Applicant's concerns set out above, be issued. Despite this request, the Applicant, of course, reserves the right to eventually file a right of Appeal notice.

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The Applicant looks forward to a timely response in this matter and it is hoped that the requested corrective action will allow for better ongoing prosecution of the Application.

Respectfully submitted,

Martin COUSINEAU, Applicant

By 
Franz BONSANG, Reg.No. 56638

CC. Mr. Daniel P. Stodola, Examiner's Supervisor, USPTO

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